

REMARKS

Request for reconsideration is respectfully requested. Claims 1 – 44 and 47 have been cancelled. Claims 68 - 73 are withdrawn. Claim 74 is newly added. Claims 45, 46, 48 – 67 and 74 are pending. Claims 45, 48, 52-53, 58 and 66 have been amended. All amendments presented herein are made for reasons of clarity with respect to the specification and drawings, and not for reasons relating to the statutory requirements for patentability.

Priority Claim under 35 U.S.C. 120

The Office Action indicated that Applicant had not complied with all of the conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120. Applicant has added a specific reference to the prior applications in the first sentence of the specification.

Drawing Objections

The Office Action objected to the drawings under 37 CFR 1.84(p)(4). Amendments to the drawings have been made in order to rectify these objections. The Office Action also objected to the drawings under 37 CFR 1.83(a). Claim 17 has been cancelled, rendering this objection moot.

Objection to the Specification under 37 CFR 1.75(d)(1)

The Office Action objected to the specification for failing to provide antecedent basis for the subject matter of claim 17. This claim has been cancelled thus rendering the objection moot, however, Applicant expressly reserves the right to present claims directed to this subject matter in the future.

Claim Rejections under 35 U.S.C. 102 and 103

Claims 45-46, 58 and 66-67 were rejected under 35 U.S.C. 102(b) for being anticipated by US 3,482,898 to Van Den Bosch. Claims 45, 47, 39-51, 60 and 66-67 were rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,231,660 to Remy in view of US 3,879,106 to McCormick or Van Den Bosch. These rejections are respectfully traversed.

Independent claim 45 has been amended to incorporate the substantive limitations of former claim 47 (now cancelled), and now recites an insulating layer within the sealed sample area for *preventing any physical contact between the two claimed conductors and a sample* disposed in said sealed sample area. This is not disclosed or suggested by Remy which clearly includes perforations in an insulating layer so as to permit physical contact between the conductors and any sample in the sample area, thus teaching away from the claimed invention. It should be appreciated that by allowing physical contact between the conductor and the sample, the prior art enables electrical conduction to occur in the sample area. However, by incorporating an insulating layer over the two claimed conductors, it is possible to study the electrostatic characteristics of the sample without regard to any electrochemical reactions that may occur in the sample if conduction were possible. Accordingly, it is respectfully submitted that independent claim 45 is patentably distinguishable over the cited prior art.

Claims 52-57 were rejected under 35 U.S.C. 103(a) as being unpatentable over Remy in view of McCormick or Van Den Bosch, further in view of US 4,849,340 to Oberhardt. This rejection is respectfully traversed. Remy discloses conductors extending into a sample area for the express purpose of creating "attraction zones". These conductors are bifurcated (i.e., do not extend continuously through the sample area) because of the necessity of providing a voltage differential required to create the attraction zones. In contrast, amended independent claim 52 requires an electrical conductor extending continuously through or under a sealed sample area and having at least two electrical contact points on opposite ends of the conductor located outside of the sealed sample area. The Examiner asserted that it would be obvious to modify the conductors of Remy in accordance with Oberhardt. However, if the Remy conductors were modified as suggested by the Examiner, *it would render Remy inoperative for intended purpose* because a continuous conductor does not present a voltage differential and thus could not be used to create the attraction. Accordingly, in view of *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), it is respectfully submitted that the person skilled in the art would have no motivation for the asserted modification.

Claims 58-59, 61 and 63-65 were rejected under 35 U.S.C. 102(b) for being anticipated by U.S. Patent No. 4,231,660 to Remy et al. ("Remy"). This rejection is respectfully traversed. Applicant respectfully submits that Remy does not disclose at least one electrical conductor, integrated with the slide base, which traverses continuously through or under the sample area and has at least two electrical contacts

located outside of the sample area, as required by amended independent claim 58. In contrast, the Remy conductor is bifurcated and does not provide a continuous conductive path in the sample area. Applicant respectfully submits that it would not have been obvious to modify the Remy conductors to be continuous for the reasons discussed above in connection with claim 52:

A similar argument is made in respect of amended independent claim 66 which was rejected under 35 U.S.C. 103(a) over Remy in view of McCormick or Van Den Bosch.

The patentability of the dependent claim derives from at least the patentability of the independent claims.

In view of the above amendments and remarks, it is believed that this application is now in a condition for allowance, and prompt issuance of a notice thereof is respectfully requested. Applicant's undersigned attorney may be contacted in our Washington, D.C. office by telephone at (202) 625-3500.

Respectfully submitted,



Attorney for Applicant
Dawn C. Hayes
Registration No.: 44,751

Patent Administrator
KATTEN MUCHIN ZAVIS ROSENMAN
525 West Monroe Street
Suite 1600
Chicago, IL 60661-3693
Facsimile: (312) 902-1061